

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 12-28 are now present in this application. Claims 12, 13, 17, and 20 are independent. Claims 1-11 have been previously canceled without prejudice to being presented in a continuing patent application.

Reconsideration of this application is respectfully requested.

I. Rejections under 35 USC §102(e)

Claims 13, 20 and 23-25 stand rejected under 35 USC §102(e) as anticipated by U.S. Patent 6,781,937 to Nakajo. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see, In re Paulsen, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994), In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990), Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Anticipation requires that each prior art reference contain within its four corners all of the elements of the claimed invention found in substantially the same situation where they do substantially the same work in the same way. *Atlas Powder Co. v. E.I. du Pont de Nemours and Co.*, 588 F.Supp. 1455 [221 USPQ 426] (N.D. Texas 1983), *aff'd*, 750 F.2d 1569 [224 USPQ 409] (Fed. Cir. 1984); *Ecolochem, Inc. v. Mobile Water Technology Co.*, 690 F.Supp. 778 [8 USPQ2d 1065] (E.D. Ark. 1988), *aff'd*, 871 F.2d 1096 [10 USPQ2d 1557] (Fed. Cir. 1989). Moreover, a rejection under 35 USC §102(e) cannot properly be based on speculation. See, in this regard, *In re GPAC, Inc.*, 35 USPQ2d 1116 at 1123 (Fed. Cir. 1995) and *Ex parte Haymond*, 41 USPQ2d 1217 at 1220 (Bd. Pat. App. & Int. 1996).

Furthermore, when relying on the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily follows from the teachings of the applied art. See, *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BD. Pat. App. & Int. 1990). There can be no speculation or only possibilities involved in a holding of inherency. What is alleged to be inherent must necessarily occur. The mere fact that something may result from a given set of circumstances is not sufficient. *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art."

Trintec Indus., Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599(Fed. Cir. 2002) (quoting In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Contrary to what is alleged in the Office Action, Nakajo does not disclose or suggest a recording unit recording optional data, as test data, onto a test area of an optical recording medium while varying a format of recording signals, as recited. Nakajo does not even discuss a test area, let alone recording unit recording optional data, as test data, onto a test area of an optical recording medium while varying a format of recording signals, as recited.

Also, contrary to what is alleged in the Office Action, Nakajo does not disclose a control unit for determining an optimum write strategy based on measured jitters. While Nakajo measures jitter, as discussed, for example, in col. 12, lines 36-45, Nakajo does not provide a control unit to determine an optimum write strategy based on measured jitters. The Office Action states that the claimed control unit is Nakajo's system controller, presumably system controller 19 shown in Fig. 6, for example. The Office Action is silent on where Nakajo discloses that its system controller 19 determined an optimum write strategy based on measured jitters, and Applicants have been unable to find such a disclosure in Nakajo. In fact, in Fig. 1, the recording strategy selecting unit 36 receives input from a disk identifying unit 32, a recording speed

selecting unit 28 and a recording strategy storage unit 34, none of which appear to provide writing strategy based on measured jitters.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of such positively recited features of claim 13.

Similar arguments apply to method claim 20, the steps of which are not anticipated by Nakajo because the claimed steps cannot be inherently (i.e., necessarily) disclosed by Nakajo's system that does not disclose or suggest Applicants' claimed system.

Dependent claims 23-25 are not anticipated by Nakajo at least because they depend from claim 20.

Reconsideration and withdrawal of this rejection of claims 13, 20 and 23-25 are respectfully requested.

II. Rejections under 35 USC §103(a)

Claims 14 and 21 stand rejected under 35 USC §103(a) as unpatentable over Nakajo in view of U.S. Patent 5,732,061 to Kirino et al. ("Kirino"). This rejection is respectfully traversed..

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual

determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. These showings must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish

prima facie obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Initially, Applicants respectfully submit that Nakajo does not anticipate claim 13, from which claim 14 depends, or claim 20, from which claim 21 depends, for reasons stated above. Moreover, Kirino is not applied in this rejection to remedy the shortcomings of Nakajo, that are explained above. Accordingly, even if one of ordinary skill in the art were properly motivated to modify Nakajo in view of Kirino, as suggested (which has not been demonstrated by objective factual evidence), the resulting modification of Nakajo would not render the claimed invention obvious.

Applicants also respectfully submit that the Office Action fails to provide objective factual evidence that one of ordinary skill in the art would have proper motivation to turn to Kirino to modify Nakajo to improve jitter when Nakajo discloses that its system results in "the jitter characteristic in the 3T land have

been greatly improved . . .” In other words, Nakajo already has improved jitter results and the Office Action provides nothing other than speculation that Kirino has improved jitter results with its system. Without objective factual evidence that Kirino’s system would at least substantially improve the already reduced jitter of Nakajo and be easy to accomplish, the Office Action fails to make out a *prima facie* case of proper motivation to modify Nakajo, which discloses greatly improved jitter characteristics, in view of Kirino, as suggested.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 14 and 21.

Claims 15 and 22 stand rejected under 35 USC §103(a) as unpatentable over Nakajo in view of JP 05-144004. This rejection is respectfully traversed.

Nakajo, the primary reference, uses a recording strategy storage unit 34 that has stored therein recording strategies, such as recording power values – see col. 10, lines 23-40. Nakajo does not disclose an extraction unit extracting a reference power value recorded on a predetermined region of the optical recording medium, nor does Nakajo disclose adapting the recording unit to vary the recording format with reference to the extracted reference power value, as recited. In other words, Nakajo operates just fine without such features. Moreover, Nakajo’s system has a filing date of 1999.

JP 05-144004 discloses a circa 1991 system that uses an optimum power test signal in a test area on a disc.

The Office Action fails to provide objective factual evidence that one or ordinary skill in the art would be properly motivated to do away with Nakajo's circa 1999 recording strategy storage unit 34 for recording power and replace it with JP 05-144004's older, circa 1991, power test area scheme, especially when Nakajo's more modern system appears to work well.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claims 15 and 22.

Reconsideration and withdrawal of this rejection of claims 15 and 22 are respectfully requested.

Claim 16 stands rejected under 35 USC §103(a) as unpatentable over Nakajo in view of U.S. Patent 5,748,584 to Maezawa. This rejection is respectfully traversed.

Claim 16 recites a combination of features including, jitter measuring means that comprise (1) a detection unit detecting a signal of specific length components from each of the reproduced signals, and detecting an inter-edge temporal difference of the length component signal from a reference signal; (2) an integration unit deriving respective inter-edge temporal difference values at leading and trailing edges of the length component signal, based on an output

signal from the detection unit, and outputting the derived values as integrated signals, respectively; and (3) a jitter calculation unit calculating a jitter of the reproduced signal, based on a signal indicative of a difference between the integrated signals.

Maezawa does not disclose any of these positively recited features. The assertion that Maezawa teaches the ability of calculating the jitter signal based on an integration of the signal difference is an overly simplistic and inaccurate summary of Maezawa which does not address most of the recited features of claim 16 and which is incorrect in that Maezawa does not appear to disclose how it determines jitter. In fact, Maezawa appears to use integration not to determine jitter, but to obtain optimum focus to reduce jitter, not to calculate or determine jitter.

In other words, Maezawa does not disclose the alleged jitter circuitry, so the Office Action fails to make out a *prima facie* case of proper motivation to turn to Maezawa to provide jitter (determining) circuitry for Nakajo, who does not use jitter determination as a control signal to determine optimum write strategy. Nor do Maezawa or Nakajo disclose most of the features recited in claim 16 so, even if they were properly combined, they would not render the claimed invention obvious.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the invention recited in claim 16.

Reconsideration and withdrawal of this rejection of claim 16 are respectfully requested.

III. Allowed Claims

Applicants acknowledge with appreciation the allowance of claims 12, 17-19 and 26-28.

IV. Conclusion

All of the stated grounds of objection and rejection have been properly traversed, Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8076, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Applicants respectfully petition under the provisions of 37 C.F.R. § 1.136(a) and § 1.17 for a one-month extension of time in which to respond to the

Examiner's Office Action. The Extension of Time Fee in the amount of **\$120.00** is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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